

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Offic**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/882,197 06/25/97 GREER

P 42390.P4072

 EXAMINER

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ART UNIT	PAPER NUMBER
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2765

*16*

DATE MAILED:

05/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

## Office Action Summary

Application No. 08/882,197	Applicant(s) Greer et al.
Examiner Susanna Melnecke-Diaz	Group Art Unit 2765

Responsive to communication(s) filed on Apr 4, 2000

This action is FINAL.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claim

Claim(s) 1-38 is/are pending in the application

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) 1-38 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

-- SEE OFFICE ACTION ON THE FOLLOWING PAGES --

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## **DETAILED ACTION**

### ***Continued Prosecution Application***

1. The request filed on April 4, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) is acceptable and a CPA has been established. An action on the CPA follows.
  
2. Claims 1-38 are currently pending.

### ***Specification***

3. The disclosure is objected to because of the following informality:  
  
Please clarify what is meant by “munging.” The Examiner thought that it was a slang term used to refer to the destruction of data, which does not seem to fit with the way it is used in the specification.

Appropriate correction is required.

### ***Claim Objections***

4. Claims 7 and 14 are objected to because of the following informalities:  
  
Claim 7, line 5, delete “a”  
  
Claim 14, line 4, delete “the target”, insert --a target-- to fix antecedent basis problem  
  
Appropriate correction is required.

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***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-38 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

While claims 1-38 are limited to the technological arts (e.g., they are limited to a computer environment), claims 1-38 are deemed non-statutory for failing to recite a practical application within the technological arts. It is not clear from the claim language what practical purpose(s) claims 1-38 set out to achieve.

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

8. Claims 1-38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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(A) In claims 1-14 and 16-38, it is not clear how one of ordinary skill in the art could make, without undue experimentation, the claimed invention such that the rule book itself generates a user specific rule, the user specific rule automatically being varied according to additional user information. A specific interpretation of the phrase in question will be addressed in the art rejection below.

Appropriate correction is required.

(B) In claims 1-13, 15, and 20-38, it is not clear how one of ordinary skill in the art could make, without undue experimentation, the claimed invention which establishes certain algorithms and criteria utilized by a triggering agent to determine if further user information is needed to allow the content provider to verify an identification code and a baseline profile for the user (or provider, in the case of claim 15). A specific interpretation of the phrase in question will be addressed in the art rejection below.

Appropriate correction is required.

(C) In claims 31-35, it is not clear how one of ordinary skill in the art could make, without undue experimentation, the claimed invention which allows one to provide a rule page just by obtaining a user profile and identifying the target computer via a rule page identification based on the user profile.

Appropriate correction is required.

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 15 and 22-26 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 15, it is unclear why the rule book would create a static and a dynamic profile of the *provider* and why a triggering agent would be determining if further provider information is needed to verify a baseline profile for the *provider*. Since content is presumably being targeted at a “user” (as disclosed in claim 1), it seems as though the user, instead of the provider, would have a corresponding static and dynamic profile.

As per claims 22-26, it is unclear how the rule page is identified to the target computer via a rule page identification number.

Appropriate correction is required.

#### ***Response to Arguments***

11. Applicant's arguments filed April 4, 2000 have been fully considered but they are not persuasive.

(A) The Applicant argues that “the Examiner fails to provide a link between the logical expression taught by Davis to the rulebook” (page 5 of the Applicant’s amendment). First, the Applicant makes an assertion without support; it is not clear what reasoning the Applicant has

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used to assert that the Examiner has not provided a link between Davis' logical expression and a rulebook. Second, as discussed in more detail below, a rulebook inherently functions based on some sort of logic. If "A" happens, then do "B". If user A spends a lot of time at web sites about dogs, then send user A advertisements about dog products. The present Examiner believes that rulebooks inherently bear a relationship to logical expressions.

(B) The Applicant argues the following:

"The Examiner contends that the agent may act continuously to record actions and build links passively or on demand based on user specific user signal such as a trigger. However, the triggering agent in the present invention is used to determine whether or not more user information is needed in order for the content provider to verify an identification code or a baseline profile for a user." (Page 5 of the Applicant's amendment)

Since this limitation is deemed to lack enablement under 112, first paragraph (as discussed above), this argument is moot.

(C) The Applicant argues that "Davis, Fitzpatrick, either taken alone or in combination, do not disclose or render obvious the use of a rulebook to **automatically being varied** according to user information or a triggering agent that can determine whether or not more user information is needed for the content provider" (page 5 of the Applicant's amendment). Again, since this limitation is deemed to lack enablement under 112, first paragraph (as discussed above), this argument is moot.

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***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-14, 16-21, 27-30, and 36-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Davis et al. (U.S. Patent No. 5,796,952) in view of Fitzpatrick et al. (U.S. Patent No. 5,423,043), as discussed in sections 7 and 8 of paper no. 12.

As per claims 1, 7, and 14, the added limitation “the rule book generating a user specific rule, the user specific rule automatically being varied according to additional user information” has been interpreted as a database which generates various rules corresponding to different conditions. For example, if it determined that a particular user is a man, the content provider then transmits the data to him if he is between the ages of 35 and 40, while, if the user is a woman, the content provider transmits the data if she is between the ages of 30 and 38. In other words, various “IF...THEN” conditions (i.e., rules) are stored in the database (i.e., rulebook). Official notice is taken that maintaining such of database of various “IF...THEN” rules for different situations is old and well-known in the art. It would have been obvious to one of ordinary skill in the art at the time of Applicant’s invention to implement Davis’ rulebook with “IF...THEN” rules for different situations in order to allow for greater precision when targeting content at different users.

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As per claims 1 and 7, the added limitation “a triggering agent to determine if further user information is needed to allow the content provider to verify an identification code and a baseline profile for the user” has been interpreted as meaning that enough data is gathered by the triggering agent so as to be able to access a uniquely corresponding identification code and a baseline profile for the user. In other words, if there are 10 users with the last name “Smith”, a first name would then be needed. Suppose the actual user is “Nicole Smith”, but there are two users named “Nicole Smith” in the system, then the system narrows the profile down to two. A third piece of uniquely identifying data is needed, such as an address or a social security number. Such a feature is necessary for Davis’ system to be operative; otherwise, a single user’s profile could not always be accessed and there would be no way of targeting content to each specific user.

Claims 15, 22-26, and 31-35 are so unclear that they have not been treated on the basis of their merits (i.e., no art has yet been applied).

### *Conclusion*

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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U.S. Patent Number	Relevance (PCT Format)	Summary
6,026,368	Y	targets advertisements based on rules
6,014,638	Y	customizes content and presentation of content based on particular user
6,009,410	Y	presents customized advertising to a user
5,991,735	Y	tracks and profiles users based on computer activity
5,978,842	Y	detects changes in a web page and notifies a user of such changes
5,948,061	Y	targets advertisements to individual users
5,933,811	Y	assigns each customer a unique member code and targets advertisements to each customer
5,931,907	Y	tracks computer user activity
5,761,644	Y	customizes an electronic secretary to each user's preferences
5,636,346	Y	targets television audiences with customized advertisements

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna Meinecke-Díaz whose telephone number is (703) 305-1337. The examiner can normally be reached Monday-Thursday from 6:30 AM to 5:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 305-0040.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

SMD  
May 13, 2000

  
ERIC W. STAMBER  
PRIMARY EXAMINER